

REMARKS/ARGUMENTS

Claims 1-5, 8-18, 21-32, 35-46, 49-56 and 59-80 are pending in this application. Claim 81 has been canceled. Claims 1, 14, 27, 41, and 55 are independent claims.

Claim Rejection 35 U.S.C. § 103

35 U.S.C. § 103(a)

When applying 35 U.S.C. §103, the following tenets of patent law must be adhered to: (A) the claimed invention must be considered as a whole; (B) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) reasonable expectation of success is the standard with which obviousness is determined. *See MPEP § 2141 and Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 220 USPQ 182, 187 n.5 (Fed. Cir. 1986).

Claims 1-5, 8-18, 21-32, 35-46, 49-56, 59, 61-62, 64-65, 67-68, 70-71 and 73-79 and 80-81 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Malik et al. ("Malik", U.S. Patent Number 6,023,701) in view of Schmid ("Schmid", Web Representation with Dynamic Thumbnails) and Brown et al. ("Brown-2", U.S. Patent Number 6,278,448). Claims 60, 63, 66, 69, and 72 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Malik in view of Schmid and Brown-2 and further in view of Gennaro et al. ("Gennaro", U.S. Patent Number 5,742,768). Applicant respectfully traverses these rejections for at least the following reasons.

Independent Claims 1, 14, 27, 41, and 55 include an element of "storing the representation of said linked second site and periodically updating the stored representation of said linked second site by at least one of the linked second site and the first site." In rejecting Claims 1, 14, 27, 41, and 55, the Patent Office indicated that Malik in view of Schmid teaches the step of storing the representation of said linked second site and updating the representation by at least one of the linked second

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site and the first site. Office Action, page 3, lines 11-13. Applicant respectfully disagrees. First, the Patent Office cites Schmid, Section 3, entitled "Dynamic Thumbnails" for such disclosure, however, such Section does not teach "storing the representation of said linked second site and updating the representation by at least one of the linked second site and the first site." Schmid, Section 3, entitled "Dynamic Thumbnails" recites:

Dynamic thumbnails are online provided and on demand rendered images of Web-pages. Generating thumbnails dynamically requires online accessible sources of the original representation. Since Web page thumbnails enhance hyper-link representation (see figure 1) and moreover Web pages are online accessible through Web servers, we chose them as sources for our thumbnails.

Schmid, Section 3, page 2. The cited section makes no mention or suggestion of "storing the representation of said linked second site and updating the representation by at least one of the linked second site and the first site." As such, Applicant respectfully requests the removal of the pending rejection for a *prima facie* case of obviousness has not been established.

In addition, the Patent Office correctly states that "the method of Matik(sic)-Schmid's does not disclose the updating to take place periodically and the representation of said linked second site to be a stored representation." Office Action, page 3, lines 11-13. The Office then relies upon Brown-2 to correct the defect found in Malik-Schmid. Office Action, page 3, lines 13-15. However, Brown-2 fails to correct such defect.

First, as previously argued, Brown-2 "provides a mechanism for creating or customizing a user interface composite desktop by selecting various components and adding them to a desktop" (emphasis added) (col. 4, lines 12-14). Col. 1, lines 19-34 of Brown-2 recites:

Prior art GUI desktops have represented such 'entry points' with icons, each of which typically fits a strict form factor (e.g., 32.times.32 pixels and a line or two of text). This type of representation does not scale well to the variety of

resources on the World Wide Web, since it is limited in size, strict in form factor, and static (unchanging). The invention described here is designed to provide a way for a GUI desktop to more adequately provide 'entry points' to Internet resources (primarily, HTML-based Web pages); these 'entry points' scale better to Web pages because: a) they can be any size (customizable by user OR by the Web author); b) the representation is not strict, and so, for instance, instead of a static icon the entry point can be used to show a 'preview' of the Web pages they point to; and c) the representation is not static but can instead change over time to reflect the changing nature of the resource (e.g. Web page) (emphasis added).

Thus, even though "the representation" of Brown-2 may be a representation of a Web page, "the representation" of Brown-2 is still part of a GUI desktop. In other words, Brown-2 attempts to establish a link between an icon of a GUI desktop and a Web page, *not* a link between two Web pages. As previously stated, this is different from Claim 1 where "a first site ... at least one of a link and a second site linked to said first site ... a representation of said linked second site" (emphasis added) is recited. Further, "the representation" of Brown-2 is a representation of a site, *not* "a representation of said linked second site" (emphasis added) recited in Claim 1. Brown-2 does not have a second site so it cannot teach or suggest "periodically updating the stored representation of said linked second site" as presently claimed.

The Patent Office asserts that Brown-2 is only being relied upon for the teaching of "periodically updating" not for the teaching of a second site. Office Action, page 8, lines 4-7. However, Matik in view of Schmid, as previously stated above, fail to teach "updating the stored representation of said linked second site by at least one of the linked second site and the first site." Thus, the combination of Matik, Schmid, and Brown-2, fails to teach, disclose or suggest "periodically updating the stored representation of said linked second site by at least one of the linked second site and the first site," as presently claimed.

Therefore, the combination of Matik, Schmid, and Brown-2, on the whole, fails to teach the present invention as claimed. To establish *prima facie* obviousness of a

claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). *See also In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970). Emphasis added. Removal of the pending rejection under 35 U.S.C. §103(a) to Claims 1-5, 8-18, 21-32, 35-46, 49-56, 59, 61-62, 64-65, 67-68, 70-71 and 73-79 and 80-81 is respectfully requested and allowance is earnestly solicited.

In addition, Claims 60, 63, 66, 69, and 72 include all claim limitations as applied in Claim 1 as well as the limitation of a pop-up menu. As correctly stated by the Patent Office, “the representation of the method of Matik, Schmid, and Brown-2 is not taught to be a pop-up menu.” (Office Action, page 6, lines 18-19). The Office then asserts Gennaro to overcome the present defect. Although the Patent Office is employing Gennaro for teaching the representation to be a pop-up menu, Gennaro does not teach or suggest “the representation being a graphical image indicative of content of said linked second site” or “periodically updating the stored representation of said linked second site” which are also lacking from the combination of Matik, Schmid, and Brown-2. Instead, Gennaro teaches “a method for providing a web page having an embedded menu to a web browser and for displaying the web page to a user of the web browser.” (Gennaro, Abstract). Thus, the combination of Matik, Schmid, Brown-2, and Gennaro, on the whole, fails to teach the present invention as claimed. Removal of the pending rejection under 35 U.S.C. §103(a) to Claims 60, 63, 66, 69, and 72 is respectfully requested and allowance is earnestly solicited.

Moreover, the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. It is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992) quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988). The fact that the Examiner must use

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multiple (up to four references) to reject the presently claimed invention suggests that the Examiner is using the prior art as a template to create such invention.

In addition, as the Examiner is well aware, Applicant is required to seasonably challenge statements by the Examiner that are not supported on the record, and failure to do so will be construed as an admission by Applicant that the statement is true. M.P.E.P. §2144.03. Therefore, in accordance with Applicant's duty to seasonably challenge such unsupported statements, the Examiner is hereby requested to cite a reference supporting the position that it would have been obvious to "update periodically information such as webpages related to a website during idle time in a networks environment" as recited in claim 8. Further, the Examiner is also requested to cite a reference supporting the position that it would have been obvious to "generate a representation indicating that the second site is not accessible" as recited in claim 12. If the Examiner is unable to provide such a reference, and is relying on facts based on personal knowledge, Applicant hereby requests that such facts be set forth in an affidavit from the Examiner under 37 C.F.R. 1.104(d)(2). Absent substantiation by the Examiner, it is respectfully requested that the rejection under 35 U.S.C. § 103 be withdrawn.

CONCLUSIONS

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons and for other reasons clearly apparent, Applicant respectfully requests reconsideration and full allowance of all claims.

If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

Respectfully submitted,
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